



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,785	04/28/2000	Alan L. Clark	200-0505	5153

32996 7590 05/13/2003

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON &  
CITKOWSKI, PC  
280 N. OLD WOODWARD AVE., STE. 400  
BIRMINGHAM, MI 48009

EXAMINER
----------

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/560,785

Applicant(s)  
Clark et al

Examiner  
Andrew J. Fischer

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 22, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Apr 22, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3627

## **DETAILED ACTION**

### ***Acknowledgments***

1. The amendment filed April 22, 2003 (Paper No. 5) is acknowledged. Accordingly, claims 1-16 remain pending.

### ***Restriction***

2. This application contains claims 8-12 drawn to an invention nonelected without traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP §821.01.

### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 22, 2003 (part of Paper No. 6) have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3627

5. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not known how “purchasing said product from said at least one identified supplier” occurs since this would make irrelevant the earlier claimed distinction of searching for *components* from particular suppliers. See the second §112 2<sup>nd</sup> paragraph rejection below.

6. Claims 13-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. In claim 13, the phrase “creating an information template having a dynamically configurable and searchable field . . .” is considered new matter. The Examiner recognizes that according to the originally filed specification, “the supplier search may be done at substantially the same time as the attributes are created within step 18.” Originally filed specification, page 8, lines 13-16. Creating the attributes appears to mean creating the content of the searchable fields. Moreover, it appears the “template” corresponds to the *supplier* and not the attributes (see e.g. amended claim 1).

Art Unit: 3627

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, the phrase beginning “causing a design file of said product to be created by performing the steps of . . .” is unclear and indefinite. Particularly, in the phrase “selectively using at least one transmitted computerized design file,” it is unclear if the “computerized design file” is associated with the *product* or associated with a *component*. On one hand the “transmitting at least one computerized design file associated with each component” indicates that the file is of the *component*. On the other hand, this file could be of the *product* created in the “causing a design file of said product to be created” since the product file has a 3-D prototype created. In other words, prior to the “selectively using” step, have the components been assembled? If no, the 3-D prototype is made from component design files. If yes, 3-D prototype is made from product design files. If Applicants intend the former, the Examiner suggests inserting “associated with each component” after “design file” and before “to create” in the “selectively using” phrase.

b. Also in claim 1, the last phrase “purchasing said product from said at least one identified supplier” is unclear. It is believed that each supplier may only supply a component. If

Art Unit: 3627

the supplier only supplies a component, it is impossible to purchase the entire product from the supplier unless the supplier is supplying all the components. Purchasing the entire product from “said at least one identified supplier” makes the whole *component*/supplier relationship (as opposed to the *product*/supplier relationship) established earlier in the claim irrelevant. It is believed Applicants intend the last phrase to indicate purchasing said *component* and not the product.

c. Also in claim 1, it is unclear in the “searching” step if the searching occurs for *all* the “specified components” or the searching can occur for just a single component. It is therefore unclear as to which components are included in the “specified components” in the “searching” step. Likewise, it is unclear in the “transmitting” step if *all* components (or alternatively a single component) have a corresponding design filed transmitted.

d. Finally in claim 1, it is unclear if Applicants intend the step of “causing a design filed of said product to be created . . . .” to include all three sub-steps of “transmitting,” “using,” and “purchasing.” A claim term may not be given a meaning repugnant its usual meaning. *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (holding that the term “perpendicular” was not allowed to mean “parallel.”)<sup>1</sup> In this case, Applicants are attempting to equate “creating a design file” with “purchasing said product . . . .” It is therefore the Examiner’s position that Applicants are attempting to use “creating a

---

<sup>1</sup> See also *In re Hill*, 161 F.2d 367, 73 USPQ 482, 484 (CCPA 1947) (A definition may not be given a meaning repugnant its usual meaning.); and MPEP §2173.05(b) subsection titled “A Term May Not Be Given a Meaning Repugnant to its Usual Meaning.”

Art Unit: 3627

design file” in a manner repugnant its usual meaning. It is believed the final “purchasing” step is not a sub-step but is instead an ordinary step in the series of claimed steps. Appropriate correction is required.

e. In claim 13, it is not known how the information template which corresponds to particular *suppliers* is dynamically configurable. See the 35 U.S.C. 112, first paragraph rejection above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 13-16, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et. al. (U.S. 6,023,683) (“Johnson ‘683”) in view of Jolliffe et. al. (U.S. 5,646,862)(“Jolliffe”). Johnson ‘683 discloses the claimed method including identifying a plurality of suppliers (the set of suppliers in the “different suppliers”, column 4, ~line 47); creating an information template for each supplier (the template fields passed via data interface 60 comprising all or a subset of the twelve fields, column 5, ~line 65 through column 6, line 3); specifying a product and each component within the product (inherent); searching (via 50)

Art Unit: 3627

each of the information templates for the specified component (searching for the desired component by e.g. part number and creating hit list 47) and thus identifying a particular supplier from the plurality of suppliers; causing a design file to be created (the hit list); transmitting at least one computerized design file associated with each component disposed within said product; selectively utilizing the design file causing the design file of the component to be created (a catalog image); purchasing the product from the identified supplier (ordering items from the order list after inventory sourcing); placing certain information on the information template related to the cost of producing the product (the product "list price"); storing the created image in a database; evaluating the design file before purchasing (the user can scroll through the hit list 47 and view an image, column 10, lines ~65 through column 11, lines ~2); creating information relating to the operation of the product (the product number) and placing it within the template; a file server 200; a local personal computer 220; fixing attributes of the product (list price, description, etc.); and the time required to provide a product or component (the availability).

Johnson '683 also discloses that the information template has a dynamically configurable and searchable field (the searcher can determine which fields to search during the search (dynamically configurable) and the values within the field itself is searchable (searchable field)).

Johnson '683 does not directly disclose creating a three dimensional prototype of a product. Jolliffe teaches that in a vendor-neutral automobile system the concept of creating a three dimensional image in a CAE system for design products and components (column 5, line 65- through column 5, line 7). Therefore, it would have been obvious to one having ordinary skill in



Art Unit: 3627

the art at the time the invention was made to modify Johnson '683 as taught by Jolliffe to include creating a three dimensional prototype of the component or product. Such a modification would have helped permit mass communication between different designs in a vendor-neutral system.

11. As noted in the previous Office Action (Paper No. 4, Paragraph No. 9), it is again the Examiner's principle position that since Johnson '683 discloses searching by product number, and the product could be a subset of a larger assembly, Johnson '683 inherently discloses searching with templates by both product and component such as in auto parts. In fact, noting in Johnson '683 prevents the parts disclosed from being auto parts. Furthermore, while one product number could refer to a product, the next product number could just as easily (and most likely does) refer to a component within an assembly or larger product. Therefore the "decomposing said product into several interconnected components" is inherent since the part number would already reflect this decomposition.

12. Functional recitations using the word "for" (e.g. "for purchasing a product" as recited in claim 1) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Art Unit: 3627

13. Claims 6 and 7, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over the Johnson '683/Jolliffe combination in further view of Danneels et. al. (U.S. 6,272,472 B1) ("Danneels"). The Johnson '683/Jolliffe combination discloses as discussed above but do not directly disclose the global computer network as the Internet. Danneels teaches the concept of using the Internet as a buyer/seller communications medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson '683 as taught by Danneels to include using the Internet to do the product searching. More and more platforms are moving from proprietary networks to Internet based systems because most companies already maintain Internet based connections. By replacing their older systems with Internet based systems, the overall costs of the system is decreased and the system is easier to maintain.

14. Since Applicants did not seasonably traverse (or inadequately traversed) the Official Notice statement(s) as stated in the previous Office Action (Paper No. 4, Paragraph No. 15), the Official Notice statement(s) are taken to be admitted prior art. See MPEP §2144.03.

15. The Examiner notes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving express notice in the previous Office Action<sup>2</sup> of the Examiner's position that lexicography is *not* invoked, Applicants have not pointed out the

---

<sup>2</sup> See the Examiner's previous Office Action mailed November 20, 2002, Paper No. 4, Paragraph No. 11.

Art Unit: 3627

“supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have not argued lexicography *is* invoked). To further support the Examiner’s position that Applicants are not their own lexicographer, it is the Examiner’s factual determination that not only have Applicants failed to point to definitional statements in their specification or prosecution history, Applicants have also failed to point to a term or terms in a claim with which to draw in those statements.<sup>3</sup> Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation<sup>4</sup> to be their own lexicographer.<sup>5</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest

---

<sup>3</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> See again the Examiner’s previous Office Action mailed November 20, 2002, Paper No. 4, Paragraph No. 11.

<sup>5</sup> The Examiner’s request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner’s request was simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed March 30, 2003).

Art Unit: 3627

reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>6</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>7</sup> See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . . .”)(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

16. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations. However, to the extent that the Examiner’s definitions are either different from or in dispute with Applicants’ definitions, the Examiner hereby adopts the following definition(s) as the broadest reasonable interpretation in all his claim interpretations:

a. **Template “3:** something that establishes or servers as a pattern”. Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

17. It is the Examiner’s position that all claimed features in claims 1-7 and 13-16 are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d

---

<sup>6</sup> See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>7</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

Art Unit: 3627

1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)).

### *Response to Arguments*

18. Applicants’ arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

19. Applicants’ amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3627

20. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Sferro et. al. (U.S. 6,230,066 B1).

22. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8<sup>th</sup> Edition, August 2001.

Art Unit: 3627

23. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 5, beginning on page 7) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied<sup>8</sup>, the Examiner respectfully requests Applicants *in their next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF  
May 7, 2003

  
**ANDREW J. FISCHER**  
**PATENT EXAMINER**

  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**

---

<sup>8</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.